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10/091,203	03/05/2002	Mingchi S. Mak	5681-10700	6376

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/091,203	MAK ET AL.
	Examiner	Art Unit	
	Thong H. Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 March 2002</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 March 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/03</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

S.00.

1.   Claims 1-32 are pending.

Claim Rejections - 35 USC § 101

2.   The claimed invention 19-32 are directed to non-statutory subject matter. (i.e. computer program).

3.   The claimed invention 19-32 lacks patentable utility. (i.e.: computer readable medium).

4.   The disclosed invention 19-32 are inoperative and therefore lacks utility. (i.e. computer readable medium).

5.   Claims 19-32 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a computer readable medium/hardware asserted utility or a well established utility.

6.   Claims 19-32 also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a computer readable medium/ hardware asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Double Patenting

7.   Claims 1-32 of this application conflict with claims 1-38 of Application No. 10/090,893. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of

demarcation between the applications. See MPEP § 822.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are provisionally rejected under the judicially created doctrine of

double patenting over claims 1-38 of copending Application No. 10/090893. This is a

provisional double patenting rejection since the conflicting claims have not yet been

patented.

The subject matter claimed in the instant application is fully disclosed in the

referenced copending application and would be covered by any patent granted on that

copending application since the referenced copending application and the instant

application are claiming common subject matter, as follows:

('893) Claim1. A system comprising:

a server comprising a document in a format supported by the server, wherein the

document is available to one or more devices via a network; a small device configured

to couple to the server;

wherein the server is <u>configured to generate a small device document in a format</u>

<u>supported by the small device from the document in the format supported by the server</u>;

wherein the small device is further <u>configured to modify the small device</u>

<u>document</u>; and

wherein the server is further configured to <u>synchronize the document in the</u>

<u>format supported by the server with a modified version of the small device document on</u>

<u>the small device</u>.

('203. Claim 1). A system comprising:
     <u>a server configured to store documents in one or more server formats, wherein the</u>
<u>documents are available to one or more devices via a network, wherein the server is configured</u>
<u>to generate a small device document in a small device format from a document in a server</u>
<u>format</u>, wherein, to generate a small device document in a small device format from a document
in a server format, the server is further <u>configured to exclude one or more formats for content of</u>
<u>the document in the server format from the small device document</u>; and
     <u>wherein the server is further configured to provide the small device document to a small</u>
<u>device coupled to the server</u>; the small device, wherein the small device is configured to:
     <u>modify the small device document to produce a modified version of the small device</u>
<u>document</u>; and
     provide the modified version of the small device document to the server; wherein the
server is further configured to generate a modified version of the document in the server format
from the modified version of the small device document, wherein, to generate a modified version
of the document in the server format from the modified version of the small device document,
the server is further configured to restore the one or more formats for content of the document in
the server format excluded from the small device document.

('203. Claim 7). configured to resolve differences between the modified version of the
document in the server format and another modified version of the document in the server format
to <u>generate a synchronized version of the document in the server format</u>.

Furthermore, there is no apparent reason why applicant would be prevented from

presenting claims corresponding to those of the instant application in the other copending

application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP

§ 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as obvious over Mendez et al

[Mendez, 6,708,221 B1] in view of Helgeson et al [Helgeson, 6,643,652 B2].

8.   As per claim 1, Mendez dislcoses A system comprising:

a server configured to store documents in one or more server formats (i.e.: global

format), wherein the documents are available to one or more devices via a network (i.e.:

Internet), wherein the server is configured to generate a client (i.e.: small device)

document in a client format from a document in a server format [Mendez, the client

format A and server global format, col 5 lines 45-64; col 6 lines 8-63], wherein, to

generate a client document in a client format from a document in a server format, the

server is further configured to exclude one or more formats for content of the document

in the server format from the client document; and

wherein the server is further configured to provide the client document to a client

device coupled to the server [Mendez, the client format A and server global format, col 5

lines 45-64; col 6 lines 8-63];

the client (wherein the small device) is configured to:

modify the client document to produce a modified version of the client document [Mendez, modified version, col 11 lines 11-56]; and

provide the modified version of the client document to the server [Mendez, server and modified folder, col 16 lines 19-48];

wherein the server is further configured to generate a modified version of the document in the server format from the modified version of the client document [Mendez, translates the changes to format used by other store, col 15 lines 5-50], wherein, to generate a modified version of the document in the server format from the modified version of the client document , the server is further configured to restore the one or more formats for content of the document in the server format excluded from the client document [Mendez, multiple servers have been modified, computes the changes to each version, reconciles the modified version, col 15 line 50-col 16 line 18].

However Mendez does not explicitly detail the client device as small device (i.e.: PDA, handheld).

In the same endeavor, Helgeson discloses a method and apparatus for managing data exchange among systems in a network wherein the web server translated its language/protocol (i.e.: HTTP) into XML prior transmission to other servers or small device (i.e.: PDA, Palm Pilot) [Helgeson, col 11 lines 39-67]; handheld devices, [Helgeson, col 55 lines 25-47]; save and restore [Helgeson, col 13 lines 10-40]; merge files, col 50 lines 43-53]; convert the XML document, conversion to an HTML, [Helgeson, col 71 lines 54-67]; handheld device using a modified version, [Helgeson, col 77 lines 20-43];

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the small device as taught by Helgeson into the Mendez's apparatus in order to utilize the modified version process. Doing so would provide the information to the Web client by sending the modified version formatted to the small devices.

9.   As per claim 2, Mendez-Helgeson disclose the document in the server format is an office productivity document [Mendez, workspace data, email, file data, col 5 lines 45-63].

10.   As per claim 3, Mendez-Helgeson disclose restore the one or more formats for content of the document in the server format excluded from the small device document, the server is further configured to:

compare modified content of the modified version of the small device document to corresponding content of the document in the server format to determine one or more formats for the modified content of the modified version of the small device document to be merged with the document in the server format [Mendez, comparing the modified version, col 11 lines 12-30]; and

merge the modified content of the modified version of the small device document into the document in the server format in accordance with the determined one or more formats for the modified content [Mendez, merge the modified version, col 16 lines 8-18].

11.   As per claim 4, Mendez-Helgeson disclose generate a modified version of the

document in the server format from the modified version of the small device document,

the server is further configured to:

determine differences between the modified version of the small device

document and the document in the server format, wherein each determined difference

indicates changed content of the modified version of the small device document

[Mendez, determine if any conflicts exist, col 15 line 50-col 16 line 7]; and

for each of the determined differences, merge corresponding changed content of

the modified version of the small device document with the document in the server

format [Mendez, merger, col 16 lines 19-48].

12.   As per claim 5, Mendez-Helgeson disclose determine differences between the

modified version of the small device document and the document in the server format,

the server is further configured to:

generate a modified version of the small device document in the server format

from the modified version of the small device document in the small device format

[Mendez, modified version, col 11 lines 11-56]; and

compare the modified version of the small device document in the server format

to the document in the server format [Mendez, comparing the modified version, col 11

lines 12-30].

13.   As per claim 6, Mendez-Helgeson disclose generate a modified version of the

document in the server format from the modified version of the small device document,

the server is further configured to:

generate a modified document in an interim format from the modified version of

the small device document [Helgeson, convert the XML document, conversion to an

HTML, col 71 lines 54-67; handheld device using a modified version, col 77 lines 20-43];

generate a document in the interim format from the document in the server

format [Mendez, the client format A and server global format, col 5 lines 45-64; col 6

lines 8-63];

determine one or more differences between the modified document in the interim

format and the document in the interim format [Mendez, determine if any conflicts exist,

col 15 line 50-col 16 line 7];

for each of the determined differences, merge corresponding changed content of

the modified document in the interim format with the document in the interim format

[Mendez, merge the modified version, col 16 lines 8-18]; and

generate the modified version of the document in the server format from the

document in the interim format [Mendez, modified version, col 11 lines 11-56].

14.   As per claim 7, Mendez-Helgeson disclose the server is further configured to

resolve differences between the modified version of the document in the server format

and another modified version of the document in the server format to generate a

synchronized version of the document in the server format [Mendez, synchronization

module, synchronization agent determine which versions have been modified, col 11 lines 11-30; col 15 line 50-col 16 line 7].

15. As per claim 8, Mendez-Helgeson disclose resolve differences between the modified version of the document in the server format and another modified version of the document in the server format, the server is further configured to:

display the differences between the modified version of the document and the other modified version of the document [Mendez, display a web page, col 8 lines 1-10; display service list, col 12 lines 34-45]; and

for each difference, accept user input specifying which version is to be used in the synchronized version of the document [Mendez, a user selects the preferred one of the modified versions, col 11 lines 42-57].

16. As per claim 9, Mendez-Helgeson disclose the server comprises a set of policies configured for use in resolving differences between versions of documents in the server format, wherein, to resolve differences between the modified version of the document in the server format and another modified version of the document in the server format, the server is further configured to, for each difference:

determine one of the polices corresponding to the difference; and apply the determined policy to the difference to determine which version is to be used in the synchronized version of the document [Mendez, synchronization module, synchronization agent determine which versions have been modified, col 11 lines 11-30;

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col 15 line 50-col 16 line 7].

17. Claims 10-32 contain the similar limitations set for claims 1-9. Therefore claims

10-32 are rejected for the same rationale set forth in claims 1-9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Rupal Dharia*, can be reached at (571) 272-3880. The fax number for the organization where this application or proceeding is assigned is 703-872-9306

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Thong Vu
Patent Examiner
Art Unit 2142